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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/776,935 00/00/00 DUMAS

J BAYER 12P1

EXAMINER

HM12/0801

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
ARLINGTON COURTHOUSE PLAZA I
2200 CLARENDON BOULEVARD
SUITE 1400
ARLINGTON VA 22201

BAHAR, M

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/776,935

Applicant(s)

DUMAS, JACQUES

Examiner

Mojdeh Bahar

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Specie Election

Claims 1-16 are generic to a plurality of disclosed patentably distinct species comprising diseases mediated by p38. Rheumatoid arthritis, osteoarthritis, osteoporosis, asthma, inflammatory bowel disease, septic shock, are some examples of diseases mediated by p38.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, **a single diseasesae**, even though this requirement is traversed. The treatment of each of these inflammatory diseases represents a separate field of medical technology having a separate field of search. For example, asthma is routinely treated differently than arthritis. Bronchodilators are routinely used in the treatment of asthma, however they are not routinely used in treating arthritis. Calcium is routinely used in treating osteoporosis, however it is not routinely used in treating inflammatory bowel disease. The search for the treatment of all diseases mediated by p38 is therefore an undue burden on the office. Note that the search is not limited to the patent files.

Claims 1-16 are generic to a plurality of disclosed patentably distinct species of formula I compounds. Claims 1-16 as presented contain such a vast multitude of possibilities and permutations in the formula I compounds that the search for each and every species encompassed in the claims presents an undue burden on the office. Accordingly, a requirement to provisionally elect a single independent and patentably distinct species is made as provided for in MPEP 803.02. These species are considered to be distinct inventions since the species are so diverse and unrelated structurally that a reference anticipating one of the species would not anticipate or render obvious the other species. Thus, the stated species are capable of supporting separate patents. To illustrate this diversity, consider the following examples: A compound of formula I containing the five membered heteroaryl containing two nitrogens, wherein B is a

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benzene ring, R1 is methyl and R2 is phenyl is classified in class 514, subclass 407; A compound of formula I containing the five membered heteroaryl containing two nitrogens, wherein B is a isoquinoline ring system, R1 is methyl and R2 is phenyl is classified in class 514, subclass 307; A compound of formula I containing the five membered heteroaryl containing two nitrogens, wherein B is a quinoline ring system, R1 is methyl and R2 is phenyl is classified in class 514, subclass 311; A compound of formula I containing the five membered heteroaryl containing two nitrogens, wherein B is a six membered heteroring having three carbons and three nitrogens, R1 is methyl and R2 is phenyl is classified in class 514, subclass 241. A compound of formula I containing the five membered heteroaryl containing one sulfur, wherein B is a benzene ring, R1 is methyl and R2 is phenyl is classified in class 514, subclass 447; A compound of formula I containing the five membered heteroaryl containing one sulfur, wherein B is a five membered heteroring containing one sulfur, R1 is methyl and R2 is phenyl is classified in class 514, subclass 444; A compound of formula I containing the five membered heteroaryl containing one sulfur, wherein B is a seven member heteroring containing one sulfur, R1 is methyl and R2 is phenyl is classified in class 514, subclass 431; A compound of formula I containing the five membered heteroaryl containing one sulfur, wherein B is tricyclic containing one five membered heteroring containing one nitrogen, R1 is methyl and R2 is phenyl is classified in class 514, subclass 411. A compound of formula I containing the five membered heteroaryl containing one oxygen, wherein B is a benzene ring, R1 is methyl and R2 is phenyl is classified in class 514, subclass 461. A compound of formula I containing the five membered heteroaryl containing one oxygen, wherein B is tricyclic containing one six membered heteroring containing three oxygens, R1 is methyl and R2 is phenyl is classified in class 514, subclass 454. A compound of formula I

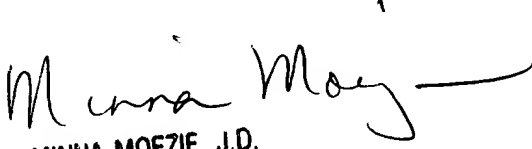
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examiner can normally be reached on (703) 305-1007 from Monday, Tuesday, Thursday and Friday from 8:30 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner
July 29, 2001


MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



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